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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,629	10/15/2003	Peter J. Ruffino	PR-CIP	2628
27797	7590	03/21/2005	EXAMINER	
RICHARD D. FUERLE 1711 W. RIVER RD. GRAND ISLAND, NY 14072			GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 10/605,629	Applicant(s) RUFFINO, PETER J.	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on Jan. 31, 2005 is acknowledged.

Claim 10 has been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on Jan. 31, 2005.

Drawings

The drawings are objected to because in figure 9 the lead line for numeral "29" is supposed to be directed to an aperture in the flap "28". However, the flap "28" does not appear to be shown so it is not clear how the apertures "29" can be shown in the flap when the flap is not shown. Further, the cross-section IX taken in figure 6 would not appear to show the flap "28" and the apertures "29" appearing in the flap. Further, in figure 9 it is not clear what element represents the aperture "29". Figure 9 does not appear to be a proper cross-section as shown in figure 6 since it appears that spring "25" would not be seen in the cross-section shown in figure 9. If figure 9 is inaccurate than figure 10 would also be inaccurate. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and

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appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,634,126 in view of Brown (U.S. Patent No. 5,301,393).

U.S. Patent No. 6,634,126 discloses in claim 1 a lottery card reading assembly comprising a lottery card reader, a clip having resiliently gripping first and second pair of arms and a single transparent flap. In regard to claims 1, 11, and 18, U.S. Patent No. 6,634,126 does not disclose making the clip from two separate pieces. Brown shows in figures 1-11 two

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embodiments that include a clip (10 or 100) that is formed from two separate pieces (12,16 or 102,104). In view of the teachings of Brown it would have been obvious to one in the art to modify claim 1 of U.S. Patent No. 6,634,126 by making the clip from two pieces since this would allow the clip to be manufactured in an easier and less expensive manner and would allow the clip to handle a wide range of document thickness, see Brown, column 2, lines 50-63. In regard to claims 2,11, and 18, Brown discloses that the two pieces (12,16, or 102,104) snap together, see column 2, lines 42-45, column 3, lines 40-42, column 6, lines 23-32. In regard to claims 4 and 18, Brown discloses in column 2, lines 67-68 that the clip pieces are molded. In regard to claims 5-9 and 13-20, U.S. Patent No. 6,634,126 discloses this structure in claims 1-10, i.e. flap can be written on in ink (claim 2), 3 to 4 inches long (claim 4), vertical reference mark (claim 5), lottery card (claim 8), and an envelope (claim 1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter (U.S. Patent No. 5,308,034).

Hunter shows in figures 1-8 a “lottery card reader” comprising a clip (14) made from two separate pieces (71 and 72) that are assembled together, the clip having a first pair of arms (the upper portions of 71 and 72, see figure 1A or 8) separated from one another and a second pair of arms (the lower portions of 71 and 72, see figure 8) resiliently biased toward one another by a

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spring (75), and a transparent flat (10) attached to the clip that can cover games on a lottery card.

In regard to claim 3, Hunter shows that the sheet (10) is a single, unfolded sheet. In regard to claim 5, the transparent sheet of Hunter is considered to be capable of being eraseably written on in ink, i.e. with the use of an eraseable ink pen or marker.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034).

Hunter does not disclose making the flap about 3 to about 4 inches long and about 1 3/4 to about 2 inches wide. It would have been an obvious matter of design choice to modify Hunter to the dimensions defined by the applicant since the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *In Gardner V. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ (Fed Cir 1984), MPEP 2144.04, IV., A.

Claims 2,4,11,12-14,18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034) in view of Brown (U.S. Patent No. 5,301,393).

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In regard to claims 4,11, and 18, Hunter does not disclose making the two separate pieces from molded plastic. Brown shows in figures 1-11 a clip that is made from molded plastic, see column 2, lines 67-68. In view of the teachings of Brown it would have been obvious to one in the art to modify Hunter by making the clip from molded plastic since this would allow the clip to be made in an easier and less expensive manner. In regard to claims 2,12, and 18, Hunter does not disclose snapping the two separate pieces together. Brown shows in figures 1-11 two embodiments that include a clip (10 or 100) that is formed from two separate pieces (12,16 or 102,104) that are snapped together, see column 2, lines 42-45, column 3, lines 40-42, column 6, lines 23-32. In view of the teachings of Brown it would have been obvious to one in the art to modify Hunter by making the clip from two pieces which snap since this would allow the clip to handle a wide range of document thickness, see Brown, column 2, lines 50-63 and would allow the clip to be assembled in an easier and faster manner. In regard to claims 13 and 19, the transparent sheet of Hunter is considered to be capable of being eraseably written on in ink, i.e. with the use of an eraseable ink pen or marker. In regard to claim 14, Hunter does not disclose making the flap about 3 to about 4 inches long and about 1 3/4 to about 2 inches wide. It would have been an obvious matter of design choice to modify Hunter to the dimensions defined by the applicant since the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *In Gardner V. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ (Fed Cir 1984), MPEP 2144.04, IV., A.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034) in view of Hull et al. (U.S. Patent No. 5,647,156).

Hunter discloses the applicant's basic inventive concept except for placing a vertical mark on the transparent flap. Hull et al. shows a transparent holder that includes indicia (32) printed on sheet (30,31,34,36) which are fixed to the holder and also discloses the idea of writing information directly onto the holder, see column 3, lines 20-22 and column 4, lines 17. In view of the teachings of Hull et al. it would have been obvious to one in the art to modify Hunter by placing a vertical mark on the transparent flap since this would allow additional information to be displayed by the holder, i.e. the vertical mark could be formed by one of the letters added to the flap, such as l or a number such as 1 or a symbol, etc.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034) in view of Brown (U.S. Patent No. 5,301,393) as applied to claim 11 and further in view of Hull et al. (U.S. Patent No. 5,647,156).

Hunter in view of Brown disclose the applicant's basic inventive concept except for placing a vertical mark on the transparent flap. Hull et al. shows a transparent holder that includes indicia (32) printed on sheet (30,31,34,36) which are fixed to the holder and also discloses the idea of writing information directly onto the holder, see column 3, lines 20-22 and column 4, lines 17. In view of the teachings of Hull et al. it would have been obvious to one in the art to modify Hunter by placing a vertical mark on the transparent flap since this would allow additional

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information to be displayed by the holder, i.e. the vertical mark could be formed by one of the letters added to the flap, such as l or a number such as 1 or a symbol, etc.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034) in view of Cross et al. (U.S. Design Patent No. 303,401).

Hunter discloses the applicant's basic inventive concept except for attaching a lottery card to the reader. Cross et al. discloses the idea of attaching a lottery ticket to a clip board. In view of the teachings of Cross et al. it would have been obvious to one in the art to modify Hunter by attaching a lottery ticket/card to the reader since this would allow the reader to be used for organizing and supporting one or more lottery tickets.

Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Patent No. 5,308,034) in view of Brown (U.S. Patent No. 5,301,393) as applied to claims 11 and 18 and further in view of Cross et al. (U.S. Design Patent No. 303,401).

Hunter in view of Brown disclose the applicant's basic inventive concept except for attaching a lottery card to the reader. Cross et al. discloses the idea of attaching a lottery ticket to a clip board. In view of the teachings of Cross et al. it would have been obvious to one in the art to modify Hunter by attaching a lottery ticket/card to the reader since this would allow the reader to be used for organizing and supporting one or more lottery tickets.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
March 15, 2005


BRIAN K. GREEN
PRIMARY EXAMINER